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REMARKS/ARGUMENTS

Claims 1-23 remain in this application. Claims 1, 4, 9 and 12 have been amended. New claims 24-25 have been added. Claims 20-23 have been withdrawn as a result of a restriction requirement. In view of the examiner's restriction requirement, applicant retains the right to present claims 20-23 in a divisional application.

1. Restriction Requirement

The Examiner issued a Restriction Requirement identifying the following groups of claims as being drawn to potentially distinct inventions:

- Group I. Claims 1-19, drawn to solid oxide fuel cells, classified in class 422, subclass 30;
- Group II. Claims 20-23, drawn to a method for making solid oxide fuel cells, classified in class 429, subclass 137; and

The Examiner asserted that these inventions may be regarded as independent and distinct from one another because "the process as claimed can be used to make another and materially different product. Specifically, the process requires a protective coating provided whereas the product has a protective coating set in place."

In a telephone conference with the undersigned attorney/agent of record dated December 22, 2006, a provisional election to Group I, claims 1-19 was made, with traverse. Applicants hereby confirm that provisional election, with traverse.

As a formality, Applicants hereby withdraw claims 20-23 from prosecution, without prejudice.

Applicants respectfully traverse the Examiner's Restriction Requirement on the grounds that the proposed inventions are not independent and distinct from one another because Claim 20 specifies that the component has a protective coating, just as it is stated in claim 1. It is noted that every element of claim 20 (a solid oxide fuel cell device, a zirconia based electrolyte, a component having a protective coating and the description of that coating) has a corresponding element in claim 1. Accordingly, the process as claimed can not be used to make another and

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materially different product, it will result in a solid oxide fuel cell device which is not materially different from that claimed in the device (Group 1) claims.

Applicants also respectfully traverse the Examiner's Restriction Requirement on the grounds that the proposed inventions are inextricably intertwined, and prosecution of the proposed groups of claims together would be most effective for the Office. In order to conduct a comprehensive search regarding any one of the groups, including the group provisionally elected above, it would be inherently necessary to review the same pertinent fields and classes of prior art relating to the other groups. Moreover, the important questions of patentability and claim interpretation are likely to be based on substantially similar issues and evaluations for each group of claims, and would require consideration of the same prior art, and combined prosecution is therefore less likely to result in inconsistent or conflicting file histories.

As such, Applicant respectfully requests that the Examiner withdraw the Restriction Requirement in the next subsequent Office Action, and continue prosecution of Groups 1 and 2, claims 1-24 together with one another.

With regard to species 1B, claims 9-19, Applicants amended claim 9 to depend from claim 1, and to additionally specify that the claimed component is a metal frame. Accordingly, claims 9-19 (species 1B) should be examined together with claims 1-8 (species 1A).

Contingent upon the Examiner's decision not to withdraw the Restriction Requirement, Applicants have withdrawn claims 20-23 from prosecution, without prejudice.

Claims 1-8 are rejected under 35 USC 102(b) as being anticipated by Quadakkers et al (US Patent 5,733,682).

Claim 1 has been amended to state that the component is a non-electrically active component. This amendment is supported, for example, by paragraph [0021], pg. 7 of the Applicants' specification, which states "In this example, the frame 50 does not provide an electrical function. In this case, and others where component 50 does not function as an electrical conductor, it is advantageous for the protective coating 60 to be non-conductive". (Emphasis added.)

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US patent No. 5,733,682 describes an aluminium enriched bi-polar plate (see, for example, Abstract). A bipolar plate is an electrically active component. Accordingly, claim 1 is not anticipated by this reference. That is, bipolar plates mechanically separate air from fuel, but also function as electrical conductors. Claims 2-8 depend from claim 1 as their dependent claims. Therefore, claims 2-8 are not anticipated, nor are obvious over this reference.

Other Claims

As stated above, Claim 9 specifically states that the claimed component is a metal frame – i.e., it is not a bipolar plate. Thus claims 9-19 are also not anticipated by the above cited reference, nor are obvious over that reference.

With regard to new claim (claim 24), a thick alumina layer or coating with a thickness of over 5 μm over at least one surface of that component, as called for in this claim, would interfere with conductivity of the bipolar plate. Accordingly, the subject matter of claim 24 is not anticipated, nor is obvious over the cited reference. In addition, the reference discloses that Al is removed from the ribs of the bipolar plate-i.e. that Al covers only portions of one surface (portions of the air facing surface) of the bipolar plate. That is, the coating does not cover at least one surface of the bipolar plate, as claimed by the applicants. Thus, the subject matter of claim 24 is not anticipated, nor is obvious over the cited reference.

Claim 25 depends from claim 1, but further specifies that the claimed device does not include a bipolar plate. Such device is disclosed, for example, on Figure 1 of Applicant's specification.

Conclusion

Based upon the above amendments, remarks, and papers of records, applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Applicant believes that no extension of time is necessary to make this Reply timely. Should applicant be in error, applicant respectfully requests that the Office grant such time extension

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pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension, and for additional two dependent claims, to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Svetlana Z. Short at 607-974-041.

DATE: 7/5/06

Respectfully submitted,

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